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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,700	11/02/2001	David Carroll Challener	RPS9 2001 0400 US2	4416
45211 7590 01/29/2007 KELLY K. KORDZIK WINSTEAD SECHREST & MINICK PC PO BOX 50784 DALLAS, TX 75201			EXAMINER NGUYEN, CINDY	
			ART UNIT 2161	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/016,700

Applicant(s)

CHALLENGER, DAVID CARROLL

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 18-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9=17 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 18-22, 24, 25 and 27 is/are rejected.
- 7) ☐ Claim(s) 7, 23 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In view of the appeal brief filed on 08/06/05, PROSECUTION IS HEREBY REOPENED. The options set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 18-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a useful result because the claimed subject matter fails to sufficiently reflect at least one practical utility set forth in the descriptive portion of the specification. More specifically, while the

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described practical utility is directed to creating a migratable storage tree and a non-migratable storage tree, the claimed subject matter relates only to the migratable storage tree and the non-migratable storage tree are identically structured, not produce a useful result apply for creating these storage.

**1. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**2. Claims 1-6, 8, 18-22, 24, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellison et al. (US 6760441) hereafter Ellison.**

Regarding claims 1 and 18, Ellison discloses: In a data processing system, a method comprising the steps of creating a migratable storage tree with a storage root key (generating a key hierarchy 310 and stored in the protected non-volatile memory of the cryptography key storage, col. 10, lines 44-45 and col. 11, lines 27-28, Ellison); and creating a non-migratable storage tree with the storage root key (creating key hierarchy 310 for protecting secrets in an isolated execution environment and key hierarchy 310 is locked into that platform as non-migratable, col. 12, lines 11-12,

Ellison), wherein the migratable storage tree and the non-migratable storage tree are identically structured with corresponding keys and authentication data (col. 3, lines 57-60 and col. 11, lines 26-30, Ellison).

Regarding claims 2 and 19, all the limitations of these claims have been noted in the rejection of claims 1 and 18. In addition, Ellison discloses: wherein the migratable storage tree and the no migratable storage tree are created by a trusted computing module in accordance with Trusted Computing Platform Alliance (protected platform col2, lines 21-33, Ellison).

Regarding claims 3 and 20, all the limitations of these claims have been noted in the rejection of claims 1 and 18. In addition, Ellison discloses: wherein the migratable storage tree comprises migratable keys and a user key, wherein the non-migratable storage tree comprises non-migratable keys and a user key (col. 6, lines 1-39, Ellison).

Regarding claims 4 and 22, all the limitations of these claims have been noted in the rejection of claims 1 and 18. In addition, Ellison discloses: wherein the non-migratable storage tree will include non-migratable storage keys corresponding to each migratable storage key in the migratable storage tree (col. 11, lines 26-30, Ellison).

Regarding claims 5 and 24, all the limitations of these claims have been noted in the rejection of claims 1 and 18. In addition, Ellison discloses: wherein use authorization in the non-migratable storage tree will be identical to use authorization in the migratable storage tree (col. 9, lines 14-28, Ellison).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Ellison discloses: further comprising the steps of

requesting a migratable storage key (col. 12, lines 51-65, Ellison); and requesting a non-migratable storage key (col. 12, lines 51-65, Ellison).

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 18 above. In addition, Ellison discloses: wherein the migratable storage tree comprises migratable keys and encrypted user data wherein the non-migratable storage tree comprises non-migratable keys and encrypted user data (col. 12, lines 24-35, Ellison).

Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 18 above. In addition, Ellison discloses: wherein use authorization in the non-migratable storage tree can be deduced from user authorization in the migratable storage tree with additional data (col. 9, lines 14-27, Ellison).

Regarding claim 27, all the limitations of this claim have been noted in the rejection of claim 18 above. In addition, Ellison discloses: wherein a migratable key can be transferred to other trusted platform module chips (col. 11, lines 40-58, Ellison) and wherein a non-migratable key cannot be transferred to other trusted platform module chips (col. 12, lines 11-12, Ellison)

### **3. Allowable Subject Matter**

Claims 7 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: in a data processing system, a method

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comprising wherein the step of requesting a non-migratable storage key will identify a parent key in the non-migratable storage tree that corresponds to the parent key in the migratable storage tree.

The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: wherein the non migratable storage tree will include non-migratable storage keys corresponding to a subset of the migratable storage keys in the migratable storage tree.

Claims 9-17 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: in a data processing system, a method comprising the steps of wherein the second command requests creating a non-migratable storage key with the given authentication data and a second parent key which is determined from looking up a key that corresponds to the first parent key in a database as recited in claim 9.

Regarding claims 10-17, these claims depend from claim 9 and are therefore allowable.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record and that encountered while searching for the claimed invention fails to anticipate and/or suggest: in a data processing system, a method comprising wherein the use authorization in the non-migratable storage tree is obtained

by hashing the concatenation of the user authorization in the migratable storage tree with a fixed string as recited in claim 26.

#### **4. Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Public key infrastructure, Streetman et al. , ATI IPT Special report 00-06, April 2000.

Lam (U.S 5564037). Real time data migration system and method employing sparse files.

Ginter et al. (U.S 6658568). Trusted infrastructure support system, method and techniques for secure electronic commerce transaction and rights management.

Brown et al. (U.S 6618806). System and method for authenticating users in a computer network.

#### **5. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gafin Jeffrey can be reached on 571-272-4146. The fax phone numbers for the



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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Cindy Nguyen  
January 13, 2007



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100